



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

**NOTICE OF ALLOWANCE AND ISSUE FEE DUE**

HM22/0618

Dehlinger & Associates  
Post Office Box 60850  
Palo Alto CA 94306

APPLICATION NO.	FILING DATE	TOTAL CLAIMS	EXAMINER AND GROUP ART UNIT	DATE MAILED
09/498,701	02/07/00	012	DESAI, R	1625 06/18/01
First Named Applicant	TROST, 35 USC 154(b) term ext. = 0 Days.			

TITLE OF INVENTION CATALYTIC COMPOSITIONS AND METHODS FOR ASYMMETRIC ALLYLIC ALKYLATION

ATTY'S DOCKET NO.	CLASS-SUBCLASS	BATCH NO.	APPLN. TYPE	SMALL ENTITY	FEE DUE	DATE DUE
1 8603-0190.2	546-002.000	H77	UTILITY	NO	\$1240.00	09/18/01

**THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED.**

**THE ISSUE FEE MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED.**

**HOW TO RESPOND TO THIS NOTICE:**

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is changed, pay twice the amount of the FEE DUE shown above and notify the Patent and Trademark Office of the change in status, or

B. If the status is the same, pay the FEE DUE shown above.

If the SMALL ENTITY is shown as NO:

A. Pay FEE DUE shown above, or

B. File verified statement of Small Entity Status before, or with, payment of 1/2 the FEE DUE shown above.

II. Part B-Issue Fee Transmittal should be completed and returned to the Patent and Trademark Office (PTO) with your ISSUE FEE. Even if the ISSUE FEE has already been paid by charge to deposit account, Part B-Issue Fee Transmittal should be completed and returned. If you are charging the ISSUE FEE to your deposit account, section "4b" of Part B-Issue Fee Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give application number and batch number.

Please direct all communications prior to issuance to Box ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.**

**PATENT AND TRADEMARK OFFICE COPY**

# Notice of Allowability

Application No.

09/498,701

Applicant(s)

Trost et al

Examiner

Rita Desai

Art Unit

1625



**-The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance and Issue Fee Due or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment filed 5/15/2001
2. ☒ The allowed claim(s) is/are 17-21 and 54-60
3. ☒ The drawings filed on 2/07/2000 are acceptable as formal drawings.
4. ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☒ Some\* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \*Certified copies not received: \_\_\_\_\_

5. ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE FOR SUBMITTING NEW FORMAL DRAWINGS, OR A SUBSTITUTE OATH OR DECLARATION.** This three-month period for complying with the REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL is extendable under 37 CFR 1.136(a).

6. ☐ Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient. A SUBSTITUTE OATH OR DECLARATION IS REQUIRED.
7. ☐ Applicant MUST submit NEW FORMAL DRAWINGS
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No. \_\_\_\_\_.
- (b) ☐ including changes required by the proposed drawing correction filed \_\_\_\_\_, which has been approved by the examiner.
- (c) ☐ including changes required by the attached Examiner's Amendment/Comment or in the Office action of Paper No. \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

8. ☐ Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Any reply to this letter should include, in the upper right hand corner, the APPLICATION NUMBER (SERIES CODE/SERIAL NUMBER). If applicant has received a Notice of Allowance and Issue Fee Due, the ISSUE BATCH NUMBER and DATE of the NOTICE OF ALLOWANCE should also be included.

## Attachment(s)

- 1 ☐ Notice of References Cited (PTO-892)
- 2 ☐ Notice of Informal Patent Application (PTO-152)
- 3 ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 4 ☐ Interview Summary (PTO-413), Paper No. \_\_\_\_\_
- 5 ☐ Information Disclosure Statement(s) (PTO-1449), Paper No(s). \_\_\_\_\_
- 6 ☐ Examiner's Amendment/Comment
- 7 ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
- 8 ☒ Examiner's Statement of Reasons for Allowance
- 9 ☐ Other

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### REASONS FOR ALLOWANCE

1. The following is an examiner's statement of reasons for allowance:

Claims pending 17-21, 54-60 corrected numbers (56-62 original numbers).

The claims 17 and 55 and 57 rejection under 35 U.S.C. 112 first para has been withdrawn since the applicants have amended the claimed and have also clarified the hetero groups , and deleted the generically claimed hetero group with 1-3 hetero atoms.

The claims 17, 20-23, 55-58 rejection under 35 U.S.C. 112 second as being indefinite since the definition of the hetero group was indefinite and also the use of nonprotic solvents was ambiguous. The applicants arguments have been persuasive. The applicants have amended the claims to delete the 3-5 heteroatoms in the ring and have also specified other non-protic solvents. The claims 17-23 and 53-56 rejection under 35 U.S.C. 103 over Barry Trost et. Al. J.Am. Chem society, Barry Trost et al Regiochemical Diversity, Barry Trost et al J..Am Chem Society, Barry Trot Organomettalics has also been withdrawn since applicants arguments are persuasive. The Barry Trot et al Organnomettalics is the only reference which teaches the chiral ligands and the ligands have a binaphthol phosphine ligands and use a palladium complex. This is not so in the instant invention and it would not have been obvious for one of ordinary skill in the art to modify it to use other metal complexes.

Thus the claims 17-21,54-60 are found to be allowable.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Desai whose telephone number is (703) -305-1868. The examiner can normally be reached on Monday to Friday from 8.00 am to 4.30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the Primary Examiner, Mr. Alan Rotman, can be reached on (703) 308-4698.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1235 .

R.D.

June 14, 2001

*Alan L. Rotman*  
ALAN L. ROTMAN  
PRIMARY EXAMINER